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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,617	11/09/2001	Mark Scott McCoy	MCOY-001COA	9302

7590

09/19/2002

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/19/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,617

Applicant(s)

MCCOY, MARK SCOTT

Examiner

Dionne A. Walls

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a method of using a two-piece smoking pipe vaporization chamber, classified in class 131, subclass 194.
- II. Claims 8-15, drawn to a two-piece smoking pipe vaporization chamber, classified in class 131, subclass 194.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product can be practiced by a materially different product, such as one not having a delivery vessel. Additionally, the product can be used in a materially different process of using the product such as igniting/burning tobacco material in the vaporization chamber and smoking said material.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Andrew Gathy on Monday, September 9<sup>th</sup>, 2002 a provisional election was made with traverse to prosecute the invention of

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Group II, claims 8-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,354,301. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are anticipated by the claims of US. Pat. No. 6,354,301 since said instant claims are broader than said patent claims. See *In Re Goodman*.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 13 recites the limitation "said at least one heated intake air turbulence member" in line 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8-11 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzner (US. Pat. No. 1,957,143) in view of Unger (US. Pat. No. 3,863,647) and Carabias (US. Pat. No. 933,360).

Kretzner discloses all that is recited in the claims (Note: "a" corresponds to the claimed "lower chamber member"; "c" corresponds to the claimed "bowl portion"; "z" corresponds to the claimed "vapor intake orifice"; "e"/ "f"/ tubular part of "a" correspond to the claimed "vapor intake conduit"; "d" corresponds to the claimed "smoking pipe conduit"; "b" corresponds to the claimed "upper chamber member") except it may not specifically disclose a lower screen member disposed in the bowl portion of the lower chamber and a generally-conical-shaped heat intake conduit. However, Unger discloses a smoking pipe having a metal screen disposed in the bowl portion of its pipe, and in another embodiment discloses the use of two screens, a second screen disclosed above the first screen in a pipe bowl – hence satisfying the limitation of claim 11 (see figs. 1 and 1A). Therefore, it would have been obvious to one having ordinary

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skill in the art at the time of the invention to modify the bowl of Kretzner to include metal screens since its known, as evidenced by this reference, to support smokable material in this manner, and so that, if desired, the upper portion having the screen in the larger portion of the bowl can be used for smoking large leafy substances, while the smaller lower bowl which contains the smaller screen can be used to smoke finely particulated substances as taught in Unger. Also, while the device of Kretzner modified by Unger may not disclose an upper chamber member including a generally-conical-shaped heat intake conduit, Carabias discloses an inhaler in the form of a smoking pipe which has a bowl B, the outlet of which is shaped in a generally conical manner (see fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source since such a source could be a match or heat gun) such that it resembled the cone shape outlet of the pipe in Carabias since a pipe having a bowl outlet of said shape is known in the tobacco art as evidence by the disclosure of Carabias. Lastly, while there may be no articulation, in the combined references, that the lower and upper chambers are mated in a substantially airtight manner, it follows that this is the case since the chambers are joined in such a manner where in they are mated by external/internal threads on the surfaces of the respective members, such threading being conventional means in which to secure/connect two pieces in an airtight manner.

Regarding claim 15, while the device of the combined references may not have the exact threaded structure of that claimed, this limitation is not deemed to patentably

distinguish the claim from the reference as the surfaces utilized to mate the two members together are obvious modifications since it is well known to utilize these means in securing items together – whether the threading is located on the exterior or interior of the respective pieces.

***Allowable Subject Matter***

11. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

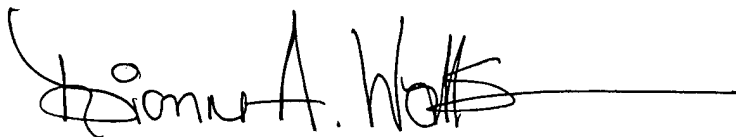
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", followed by a long horizontal line extending to the right.

Dionne A. Walls  
September 17, 2002